

REMARKS

35 USC § 101

The examiner rejected claims 1, 6, 8-10, 19, 20, 25 and 26 under 35 U.S.C. 101 as directed to non-statutory subject matter.

The examiner stated:

Claims 1, 6, 8-10, 25 and 26 discuss methods, however, based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class, such as a particular apparatus, or (2) transform underlying subject matter, such as an article or materials, into a different state or thing. If neither of these requirements is met by the claim, the method is not a patent eligible process under § 101 and should be rejected as being directed to non-statutory subject matter. See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n. 9 (1978); *Gottsealk v. Benson*, 409 U.S. 63, 70-71 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

Claims 1, 6, 8-10, 25 and 26 recite a method for quoting securities, but do not tie the method to any other statutory subject matter, such as a computer platform, to perform the steps detailed in claims 1, 6, 8-10, 25 and 26.

Claims 19 and 20 recite functional descriptive material *per se* ("computer program product"), therefore, the claims are non-statutory.

Although Applicant believes that the claims prior to amendment were directed to statutory subject matter, in order to advance prosecution, Applicant has amended claims 1 and 10 to recite a particular machine in each of these claims and thus claims 1, 6, 8-10, 19, 20, 25 and 26 under 35 U.S.C. 101 are directed to statutory subject matter.

Claims 19 and 20 are directed to statutory subject matter. Claim 19 recites: "A computer program product residing on a computer readable medium for providing quotations for securities, the computer program product comprising instructions for causing a computer to" perform recited functions. Appellant has claimed a novel article of manufacture, namely a computer readable medium on which is stored the claimed computer program product. In, *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994), the court specifically found that:

The Board reversed the 35 U.S.C. Section 101 rejection. The Board found that claims 1 through 5, directed to a memory containing stored information, as a whole, recited an article of manufacture. The Board concluded that the invention claimed in claims 1 through 5 was statutory subject matter. *Lowry* 32 F.3d at

In *Lowry*, the claims were found statutory by the Board because the claims were to a memory, i.e., an article of manufacture. The Board acknowledged the statutory nature of the memory, but then proceeded to apply the so-called printed matter doctrine and was subsequently reversed by the Federal Circuit. Appellant's claim 19 recites an article of manufacture, namely "a computer program product on a computer readable medium." The Patent Office's own guidelines to patenting of Computer related inventions does not support the position taken by the examiner.¹

Claim 19 is not directed to a method as in *In re Bilski* __ F.3d __ (Fed. Cir. 2008) nor a propagated signal as in *In re Comiskey*, 499 F.3d 1365, 1371 (Fed. Cir. 2007) and does not claim nonfunctional descriptive materials such as music, literary works and a compilation or mere arrangement of data. Rather, claim 19 claims instructions to a novel and non-obvious article of manufacture, a computer readable medium on which is a computer program product for providing quotations for securities.

The examiner indicated allowable subject as:

Claims 11 -18 are allowed over the prior arts cited of record.

Claims 2-5, 7 and 21 -24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

¹ "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data. Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se. *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 158384, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). MANUAL OF PATENT EXAMINING PROCEDURE §2106 page 2100-12 rev. May 20.04

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All of the dependent claims are patentable for at least the reasons for which the claims on which they depend are patentable.

Canceled claims, if any, have been canceled without prejudice or disclaimer.

Any circumstance in which the applicant has (a) addressed certain comments of the examiner does not mean that the applicant concedes other comments of the examiner, (b) made arguments for the patentability of some claims does not mean that there are not other good reasons for patentability of those claims and other claims, or (c) amended or canceled a claim does not mean that the applicant concedes any of the examiner's positions with respect to that claim or other claims.

All claims are now allowable. In view of the length of prosecution of this application Applicant requests allowance at the earliest possible convenience of the examiner.

The Petition for Extension of Time fee of \$490 is being paid concurrently on the electronic filing system by way of deposit account authorization. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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